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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/895,426

06/28/2001

Miguel N. Bermudez

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Todd M. Becker
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025-1026

EXAMINER

FRANKLIN, JAMARA ALZAIDA

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/895,426

Applicant(s)

BERMUDEZ, MIGUEL N.

Examiner

Jamara A. Franklin

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10,12-17 and 27-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10,12-17 and 27-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgment is made of the amendment entered on 8/23/04. Claims 10, 12-17, and 27-38 are currently pending.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/23/04 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 10, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US 6,697,812) in view of Egan (US 6,273,986).

Martin teaches a method comprising:

reading a unique identifier stored on a component (col. 5, lines 5-15);

printing the unique identifier read from the component onto first and second labels; and

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affixing the first and second labels to a component container into which the component is inserted (col. 6, lines 25-39);

the method wherein printing the unique identifier on the first and second labels comprises encoding the identifier in a bar code and printing the bar code on the labels (col. 2, lines 27-37); and

the method wherein reading the unique identifier of the component comprises reading an electronically encoded identifier from the component.

Martin lacks the specific teaching of removably affixing the first and second labels.

Egan teaches removably affixing a label (col. 6, lines 35-44).

One of ordinary skill in the art would have readily recognized that providing the Martin invention with the ability to functionally removably affix the first and second labels would have been beneficial for not making the label a permanent fixture on the component. Therefore, it would have been obvious, at the time the invention was made, to modify the Martin invention with the aforementioned element as taught by Egan.

4. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin/Egan as applied to claim 10 above, and further in view of Peltier (US 6,671,611).

The teachings of Martin/Egan have been discussed above.

Martin/Egan lacks the teaching of attaching the first label on a device in which the component is installed.

Peltier teaches attaching a label on a device in which the component is installed (col. 14, line 54-col. 15, line 3).

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One of ordinary skill in the art would have readily recognized that attaching a label on a device in which the component is installed would have been beneficial for providing a record as to which device a particular component may have been installed. Therefore, it would have been obvious at the time the invention was made, to modify the teachings of Martin/Egan with the aforementioned teaching of Peltier.

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin/Egan as applied to claim 10 above, and further in view of Adams (US 4,585,254).

The teachings of Martin/Egan have been discussed above.

Martin/Egan lacks the teaching of the label being made of polyester.

Adams teaches labels made of polyester (col. 2, lines 44-49).

One of ordinary skill in the art would have readily recognized that label made of polyester are able to withstand wear and tear without substantially damage to the label. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Martin/Egan with the polyester label as taught by Adams to make the label durable.

6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin/Egan as applied to claim 10 above, and further in view of Freund et al. (US 6,088,212) (hereinafter referred to as 'Freund').

The teachings of Martin/Egan have been discussed above.

Martin/Egan lacks the teaching of the container as an electro-static discharge bag.

Freund teaches an electrostatic discharge bag (col. 5, lines 1-5 and col. 6, lines 24-28).

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One of ordinary skill in the art would have readily recognized that an electro-static discharge bag is one of a variety of container that may benefit from a label being affixed thereto to allow one to recognize the contents of the bag. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Martin/Egan with the electro-static discharge bag of Freund.

Claim Rejections - 35 USC § 103

7. Claims 27, 30, 33, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin/Egan in view of Chiles et al. (US 6,363,423).

The teachings of Martin/Egan have been discussed above.

Martin/Egan lack the teaching of a Media Access Control address.

Chiles teaches a Media Access Control address on a network interface card (col. 5, line 64-col. 6, line 5).

One of ordinary skill in the art would have readily recognized that reading the Media Access Control address would have been beneficial to the Martin/Egan for properly identifying and labeling a card to be packaged. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Martin/Egan with the Media Access Control address as taught by Chiles.

8. Claims 28, 29, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marin/Egan/Chiles as applied to claims 27 and 33 above, and further in view of Peltier.

Martin/Egan/Chiles lacks the teaching of attaching the first label on a device in which the

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component is installed.

Peltier teaches attaching a label on a device in which the component is installed (col. 14, line 54-col. 15, line 3).

One of ordinary skill in the art would have readily recognized that attaching a label on a device in which the component is installed would have been beneficial for providing a record as to which device a particular component may have been installed. Therefore, it would have been obvious at the time the invention was made, to modify the teachings of Martin/Egan/Chiles with the aforementioned teaching of Peltier.

9. Claims 31 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin/Egan/Chiles as applied to claims 27 and 33 above, and further in view of Adams.

The teachings of Martin/Egan/Chiles have been discussed above.

Martin/Egan lacks the teaching of the label being made of polyester.

Adams teaches labels made of polyester (col. 2, lines 44-49).

One of ordinary skill in the art would have readily recognized that label made of polyester are able to withstand wear and tear without substantially damage to the label. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Martin/Egan/Chiles with the polyester label as taught by Adams to make the label durable.

10. Claims 32 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin/Egan/Chiles as applied to claims 27 and 33 above, and further in view of Freund.

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The teachings of Martin/Egan/Chiles have been discussed above.

Martin/Egan lacks the teaching of the container as an electro-static discharge bag.

Freund teaches an electrostatic discharge bag (col. 5, lines 1-5 and col. 6, lines 24-28).

One of ordinary skill in the art would have readily recognized that an electro-static discharge bag is one of a variety of container that may benefit from a label being affixed thereto to allow one to recognize the contents of the bag. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Martin/Egan/Chiles with the electro-static discharge bag of Freund.

Response to Arguments

11. Applicant's arguments filed 8/23/04 have been fully considered but they are not persuasive.

Regarding the arguments that Martin does not disclose that identifying information read from an item should be printed on more than one label, nor that more than one label including the same identifying information should be attached to a container in which the item is placed, the examiner submits that the Martin reference teaches that “**labels** could be applied to packaging” (see col. 6, lines 36-39). The examiner also submits that since the item is contained in a package, the package is then a **container**, and therefore reads upon the limitation citing “affixing the first and second labels to a container into which the component is inserted”.

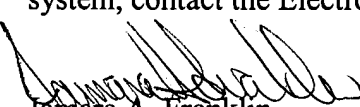
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamara A. Franklin whose telephone number is (571) 272-2389. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jamara A. Franklin
Examiner
Art Unit 2876

JAF
September 3, 2004



DIANE I. LEE
PRIMARY EXAMINER